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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 015.0405.US.CON						
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<table border="1"> <tr> <td>Application Number 10/774,301</td> <td>Filed 02/06/2004</td> </tr> <tr> <td colspan="2">First Named Inventor Jeremy Irish</td> </tr> <tr> <td>Art Unit 3664</td> <td>Examiner Ronnie M. Mancho</td> </tr> </table>			Application Number 10/774,301	Filed 02/06/2004	First Named Inventor Jeremy Irish		Art Unit 3664	Examiner Ronnie M. Mancho
Application Number 10/774,301	Filed 02/06/2004							
First Named Inventor Jeremy Irish								
Art Unit 3664	Examiner Ronnie M. Mancho							

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number _____



Signature

Krista A. Wittman

Typed or printed name

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. 59594

March 2, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

15 **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

20 Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants request review of the Final Office action mailed on October 29, 2008 for the above-referenced patent application. A Notice of Appeal is being filed with the request. The review is requested for the reasons stated below.

25 **Rejections under 35 U.S.C. § 112, first paragraph - Enablement**

Claims 1-5 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. However, the rejection is improper since one or more essential elements needed for a *prima facie* rejection have been omitted.

“The test of enablement is whether one reasonably skilled in the art could make or use the invention without undue experimentation.” MPEP 2164.01 (citing *U.S. v. Telelectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988)). However, to properly make the rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. MPEP 2164.04. “A specification disclosure, which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement

of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.” *Id.* Minimally, reasons for the uncertainty of the enablement are required to be provided, such as an explanation for doubting the truth or accuracy of any statement in a supporting disclosure (emphasis added). *Id.*

5 The Final Office Action of October 29, 2008 fails to provide reasons or evidence to support doubt of the objective truth of the statements made in the disclosure. Instead, the Final Office Action generally asserts that particular phrases were “copied from the specification and pasted in the claims without any 10 description to enable one skilled in the art to make and use the invention.” Final Office Action, pages 2-3, point 2. Notwithstanding, Applicant provided support for the aforementioned phrases in a Response to Office Action, filed on July 7, 2008, on page 8, line 5 to page 11, line 8 and in a Response to Final Office Action, filed on December 29, 2008, on page 8, line 6 to page 11, line 18.

15 However, contrary to a *prima facie* showing of enablement, the objective truth of the statements contained in the specification and indicated above, have not been called into doubt by the Final Office Action of October 29, 2008. Identifying phrases and stating that the phrases were copied without any description is not acceptable evidence or reasoning for a rejection of enablement. 20 Accordingly, the enablement rejection is inappropriate since a *prima facie* showing has not been met.

Rejections under 35 U.S.C. § 112, first paragraph – Written Description

Claims 2 and 3 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. However, the 25 rejection is improper since one or more essential elements needed for a *prima facie* rejection have been omitted.

A specification must contain a written description of an invention sought to be patented. MPEP 2163(I). The specification must describe the claimed invention in sufficient detail to enable one skilled in the art to reasonably 30 conclude that the inventor had possession of the claimed invention. *Id.* Under the written description requirement, newly added claim limitations must be expressly,

implicitly, or inherently supported in the specification. MPEP 2163(I)(B).

Support for Claims 2 and 3 are provided in the specification on page 4, lines 5-7 (“to locally trigger each user navigational event associated with the timed event”) and on page 9, lines 1-7 (“to determine trigger condition

5 satisfaction of one or more of the independent trigger conditions”). Therefore, the rejection is not appropriate since a *prima facie* showing of lack of a written description has not been made.

Rejections under 35 U.S.C. § 102(e) over Sprogis

Claims 1-5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by 10 U.S. Patent No. 6,320,495 to Sprogis. However, one or more essential elements need for a *prima facie* rejection have been omitted, as described below.

A claim is anticipated under 35 U.S.C. § 102(e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP 1231. Sprogis fails to teach each and every 15 element of Claims 1-5. Rather, Sprogis discloses a treasure hunt type game that utilizes global positioning satellite (GPS) equipped wireless communication devices (Abstract). Players are given clues or directions to proceed along a treasure hunt route based upon their location as determined by a GPS receiver (Abstract; Col. 2, lines 3-20 and 67-Col. 3, lines 4-18; Col. 5, lines 11-29). A 20 gamemaster computer program (gamemaster) is designed to run the treasure hunt from a central Website (Col. 3, lines 4-5, 19-26 and 51-55). The gamemaster maintains a general map of the treasure hunt territory, which is divided into a plurality of smaller segments, each assigned a unique number (Col. 4, lines 15-19). The players’ GPS receivers receive locational data, which is transmitted back to the gamemaster by the wireless communications device (Col. 3, lines 5-8). The 25 gamemaster then determines the next clue to be given to a player based upon the player’s location in relation to a particular segment, as well as other variables, such as the number of clues the player has correctly answered and the position of other players (Col. 2, lines 12-16; Col. 3, lines 9-15; and Col. 5, lines 8-25).

30 Specifically, Sprogis fails to teach a storage medium configured to hold data in a cartridge script loadable into a wireless computing device, event data

configured to define one or more user navigational events into the cartridge script and configured to associate each user navigational event with at least one zone of influence, and a wireless computing device with a processing module configured to determine a correlation between dynamic geolocational data of the wireless

5 computing device and static geolocational data for one or more of the zones of influence and configured to locally trigger the user navigational event associated with the zone based on the correlation, per Claim 1, for the reasons set forth on page 12, line 5 to page 13, line 30 of the Response to Office Action filed on July 7, 2008 and on page 11, line 30 to page 14, line 15 of the Response to Final

10 Office Action filed on December 29, 2008.

Further, Sprogis teaches a system for playing a treasure hunt game, which includes one or more wireless communication devices and a centralized gamemaster (Col. 2, line 67-Col. 3, line 5). The gamemaster maintains location information received from each wireless communication device, as well as a map 15 of the treasure hunt (Col. 3, line 65-Col. 4, line 2; Col. 4, lines 15-18). Once the location information is received from one of the wireless communication devices, the gamemaster dynamically determines a clue for transmitting back to the wireless communication device based on the location information received and other variables (Col. 4, lines 1-4). Thus, the wireless communication device 20 transmits data to and receives data from the gamemaster and fails to load a cartridge script of user navigational events and zone of influences, to determine a correlation between dynamic geolocational data of a wireless computing device and static geolocational data for one or more of the zone of influences, and to trigger one or more user navigational events based on the correlation. Therefore, 25 a *prima facie* showing of anticipation has not been made.

Accordingly, for the reasons set forth above, withdrawal of the rejections and a Notice of Allowance are earnestly solicited.

Pre-Appeal Brief Request for Review
Docket No. 015.0405.US.CON

Respectfully submitted,

5 Dated: March 2, 2009

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Pre-Appeal Brief Request for Review